

AMENDMENTS

In the Claims

Please substitute the following clean copy text for the pending claims of the same number.

- 1 6. (Once Amended) The system of claim 5, further comprising a scanner configured to
2 scan a label of said package and to identify said one package based on said label, wherein said
3 system manager detects that said package has been assigned to said vehicle based on whether said
4 scanner has identified said one package.
-

REMARKS

This is a full and timely response to the outstanding nonfinal Office Action mailed June 19, 2002. Reconsideration and allowance of the application and presently pending claims, as amended, are respectfully requested.

1. Present Status of Patent Application

Upon entry of the amendments in this response, claims 1-23 remain pending in the present application. Claim 6 has been amended to correct a minor informality and was not amended for reasons of patentability. Therefore, the foregoing amendment adds no new matter to the present application. Please see the appendix for the "Annotated Version of Modified Claims to Show Changes Made."

2. Response to Rejection of Claims 1-4 Under 35 U.S.C. § 103(a)

Claims 1-4 have been rejected under 35 U.S.C. § 103(a) as being purportedly unpatentable over *Schmier* (U.S. Patent No. 6,006,159) in view of Applicant's own disclosure. It is well established at law that, for a proper rejection of a claim under 35 U.S.C. § 103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly, all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

For a proper rejection under 35 U.S.C. § 103, both the suggestion to combine the combination of references and the expectation of success of the combination must be found in the prior art, not in the Applicant's disclosure. *See In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). There is no suggestion anywhere in the prior art of record to combine the teachings of these two references. Simply put, the Official Action has used Applicant's disclosure as a template or instruction manual to combine the references in order to fabricate the combination.

a. Claim 1

As provided in independent claim 1, Applicant claims:

1. A system for reporting impending vehicle deliveries, comprising:
 - memory storing a vehicle schedule, said vehicle schedule
 - identifying packages that are to be delivered by a vehicle during a first time period and indicating an order that said vehicle is expected to deliver said packages;
 - a first communications device configured to establish communication with remote communications devices; and
 - a system manager configured to analyze said vehicle schedule and to determine, based on said order, a second time period that said vehicle is expected to deliver one of said packages, said system manager***

further configured to transmit a notification message via said first communications device, said notification manager identifying said second time period,

wherein said second time period is within said first time period.

(emphasis added).

Irrespective of the clear lack of motivation to combine the prior art references, Applicant asserts that the rejection is improper because, even if the teachings of the references were properly combinable, such combination would not result in Applicant's claimed invention. As provided above, Applicant's independent claim 1 recites a system comprising a system manager configured to analyze a vehicle schedule that identifies packages that are to be delivered in a certain order by a vehicle. The *Schmier*/disclosure combination would not result in the claimed system for at least the reason that the passenger delivery system in *Schmier* does not "identify[] packages that are to be delivered by a vehicle," "indicat[e] an order that said vehicle is expected to deliver said packages," and does not "determine, based on said order, a second time period that said vehicle is expected to deliver one of said packages," as recited in claim 1. Therefore, the *Schmier*/disclosure combination simply would not result in Applicant's claimed invention. Accordingly, the rejection of claim 1 is improper and should be withdrawn.

b. Claims 2-3

Because independent claim 1 is allowable over the prior art of record, dependent claims 2-3 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that the dependent claims 2-3 contain all the elements/features of independent claim 1. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Therefore, claims 2-3 are not obvious under the proposed combination of *Schmier* in view of Applicant's own disclosure, and the rejection should be withdrawn.

c. Claim 4

Because independent claim 1 is allowable over the prior art of record, dependent claim 4 (which depends from independent claim 1) is allowable as a matter of law for at least the reason that the dependent claim 4 contains all the elements/features of independent claim 1. Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claim 4 recites further features and/or combinations of features (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record. Specifically, the feature “wherein said vehicle schedule identifies each recipient that is to receive at least one of said packages, said notification message identifying each of said packages to be received by one of said recipients during said first time period,” as recited in claim 4, is not disclosed or suggest by either *Schmier* or Applicant’s disclosure. For example, the system in *Schmier* apparently does not identify in notification messages which packages are to be received by a particular recipient. Hence, the *Schmier*/disclosure combination simply would not result in Applicant’s claimed invention. Accordingly, the rejection of claim 4 is improper and should be withdrawn.

3. Response to Rejection of Claims 5-7, 9, 10, 12-19, and 21 Under 35 U.S.C. § 103(a)

Claims 5-7, 9, 10, 12-19, and 21 have been rejected under 35 U.S.C. § 103(a) as being purportedly unpatentable over *Schmier* (U.S. Patent No. 6,006,159) in view of Applicant’s own disclosure and *Hitchcock*, “The Big Hiccup” (April 1996). It is well established at law that, for a proper rejection of a claim under 35 U.S.C. § 103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly, all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

For a proper rejection under 35 U.S.C. § 103, both the suggestion to combine the combination of references and the expectation of success of the combination must be found in the prior art, not in the Applicant's disclosure. *See In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). There is no suggestion anywhere in the prior art of record to combine the teachings of these references. Simply put, the Official Action has used Applicant's disclosure as a template or instruction manual to combine the references in order to fabricate the combination.

a. Claim 5

As provided in independent claim 5, Applicant claims:

5. A system for reporting impending vehicle deliveries, comprising:
memory storing package data identifying a plurality of packages that are to be respectively delivered to a plurality of recipients;
a first communications device configured to establish communication with remote communications devices; and
a system manager configured to detect when one of said packages has been assigned to a vehicle for delivery to one of said recipients, said system manager further configured to transmit a notification message via said first communications device in response to a detection that said one of said packages has been assigned to said vehicle.

(emphasis added).

Irrespective of the clear lack of motivation to combine the prior art references, Applicant asserts that the rejection is improper because, even if the teachings of the references were properly combinable, such combination would not result in Applicant's claimed invention. As provided above, Applicant's independent claim 5 recites a system comprising a "system manager configured to detect when one of said packages has been assigned to a vehicle for delivery to one of said recipients, said system manager further configured to transmit a notification message via said first communications device in response to a detection that said one of said packages has been assigned

to said vehicles.” The *Schmier*/disclosure/*Hitchcock* combination would not result in the claimed system for at least the reason that the passenger delivery system in *Schmier* apparently does not assign packages to particular vehicles and therefore cannot detect when a particular package has been assigned to a vehicle. Hence, the *Schmier*/disclosure/*Hitchcock* combination simply would not result in Applicant’s claimed invention. Accordingly, the rejection of claim 5 is improper and should be withdrawn.

b. Claim 6

Because independent claim 5 is allowable over the prior art of record, dependent claim 6 (which depends from independent claim 5) is allowable as a matter of law for at least the reason that the dependent claim 6 contains all the elements/features of independent claim 5. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for allowability of independent claim 5, dependent claim 6 recites further features and/or combinations of features (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record.

Specifically, the feature “wherein said system manager detects that said package has been assigned to said vehicle based on whether said scanner has identified said one package,” as recited in claim 6, is not disclosed or suggest by either *Schmier*, Applicant’s disclosure, or *Hitchcock*. The *Schmier*/disclosure/*Hitchcock* combination would not result in the claimed system for at least the reason that the passenger delivery system in *Schmier* apparently does not assign particular packages to particular vehicles and therefore cannot detect such assignments. Hence, the *Schmier*/disclosure/*Hitchcock* combination simply would not result in Applicant’s claimed invention. Accordingly, the rejection of claim 6 is improper and should be withdrawn.

c. Claim 7

Because independent claim 5 is allowable over the prior art of record, dependent claim 7 (which depends from independent claim 5) is allowable as a matter of law for at least the reason that the dependent claim 7 contains all the elements/features of independent claim 5. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

d. Claim 9

Because independent claim 5 is allowable over the prior art of record, dependent claim 9 (which depends from independent claim 5) is allowable as a matter of law for at least the reason that the dependent claim 9 contains all the elements/features of independent claim 5. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for allowability of independent claim 5, dependent claim 9 recites further features and/or combinations of features (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record.

Specifically, the feature “wherein said notification message identifies a sender of said one package,” as recited in claim 9, is not disclosed or suggested by either *Schmier*, Applicant’s disclosure, or *Hitchcock*. For example, *Schmier* seemingly suggests broadcasting information regarding the location and arrival of transit vehicles and does not transmit information regarding the sender of a package that is to be delivered by a delivery vehicle. Therefore, the *Schmier*/disclosure/*Hitchcock* combination simply would not result in Applicant’s claimed invention. Accordingly, the rejection of claim 9 is improper and should be withdrawn.

e. Claim 10

Because independent claim 5 is allowable over the prior art of record, dependent claim 10 (which depends from independent claim 5) is allowable as a matter of law for at least the reason that the dependent claim 10 contains all the elements/features of independent claim 5. Additionally and notwithstanding the foregoing reasons for allowability of independent claim 5, dependent claim 10 recites further features and/or combinations of features (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record.

Specifically, the feature “wherein said package data indicates that said packages are to be delivered by said vehicle and indicates an order that said vehicle is expected to deliver said packages, and wherein said system manager is further configured to determine, based on said order, that said one package is expected to be delivered during a particular time period, said notification message indicating that said one package is expecting to be delivered during said particular time period,” as recited in claim 10, is not disclosed or suggest by either *Schmier*, Applicant’s disclosure, or *Hitchcock*. For example, a passenger notification system of *Schmier* does not disclose, teach, or suggest an order for delivering packages that can be incorporated or combined with a barcode system of *Hitchcock* to result in the system of claim 10. Therefore, the *Schmier*/disclosure/*Hitchcock* combination simply would not result in Applicant’s claimed invention. Accordingly, the rejection of claim 10 is improper and should be withdrawn.

f. Claim 12

As provided in independent claim 12, Applicant claims:

12. A method for reporting impending vehicle deliveries, comprising the steps of:

receiving a plurality of packages;
assigning each of said packages to a vehicle;

determining an order that said vehicle is to deliver said packages;
determining, based on said order, a first time period that said vehicle is
expected to deliver one of said packages to a recipient;
causing a notification message to be transmitted to said recipient based on
said determining a first time period step;
indicating said first time period via said notification message; simultaneously
transporting each of said packages via said
vehicle; and
transporting said one package to a premises of said recipient via said vehicle.

(emphasis added).

Irrespective of the clear lack of motivation to combine the prior art references, Applicant asserts that the rejection is improper because, even if the teachings of the references were properly combinable, such combination would not result in Applicant's claimed invention. As provided above, Applicant's independent claim 12 recites a method comprising the steps of "receiving a plurality of packages; assigning each of said packages to a vehicle; determining an order that said vehicle is to deliver said packages" The *Schmier/disclosure/Hitchcock* combination would not result in the claimed method for at least the reason that the passenger delivery process in *Schmier* apparently does not assign particular packages to vehicles and does not determine an order of delivery for the packages. Hence, the *Schmier/disclosure/Hitchcock* combination simply would not result in Applicant's claimed invention. Accordingly, the rejection of claim 12 is improper and should be withdrawn.

g. Claim 13

Because independent claim 12 is allowable over the prior art of record, dependent claim 13 (which depends from independent claim 12) is allowable as a matter of law for at least the reason that the dependent claim 13 contains all the steps of independent claim 12. See *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

h. Claim 14

Because independent claim 12 is allowable over the prior art of record, dependent claim 14 (which depends from independent claim 12) is allowable as a matter of law for at least the reason that the dependent claim 14 contains all the steps of independent claim 12. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for allowability of independent claim 12, dependent claim 14 recites further steps and/or combinations of steps (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record.

Specifically, the step of “determining whether each of said packages is expected to be delivered during a second time period,” as recited in claim 14, is not disclosed or suggest by either *Schmier*, Applicant’s disclosure, or *Hitchcock*. Particularly, *Schmier* does not appear to determine whether a particular package is to be delivered during a time period. Therefore, the *Schmier*/disclosure/*Hitchcock* combination simply would not result in Applicant’s claimed invention. Accordingly, the rejection of claim 14 is improper and should be withdrawn.

i. Claim 15

Because independent claim 12 and dependent claim 14 are allowable over the prior art of record, dependent claim 15 (which depends from independent claim 12 and dependent claim 14) is allowable as a matter of law for at least the reason that the dependent claim 15 contains all the steps of independent claim 12 and dependent claim 14. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

j. Claim 16

As provided in Applicant's independent claim 16, Applicant claims:

16. A method for reporting impending vehicle deliveries, comprising the steps of:

receiving a package for delivery to a premises of a recipient;

assigning said package to a vehicle;

detecting when said package is assigned to said vehicle;

producing a notification message in response to said detecting step, said notification message indicating a time period in which said package is expected to be delivered at said premises;

transmitting said notification message to a communication device located at said premises; and

transporting said package to said premises via said vehicle.

(emphasis added).

Irrespective of the clear lack of motivation to combine the prior art references, Applicant asserts that the rejection is improper because, even if the teachings of the references were properly combinable, such combination would not result in Applicant's claimed invention. As provided above, Applicant's independent claim 16 recites a method comprising the steps of "receiving a package for delivery to a premises of a recipient; assigning said package to a vehicle; detecting when said package is assigned to said vehicle" The *Schmier*/disclosure/*Hitchcock* combination would not result in the claimed method for at least the reason that the passenger delivery process in *Schmier* apparently does not assign a particular package to a vehicle and therefore cannot detect when a particular package has been assigned to a vehicle. Hence, the *Schmier*/disclosure/*Hitchcock* combination simply would not result in Applicant's claimed invention. Accordingly, the rejection of claim 16 is improper and should be withdrawn.

k. Claim 17

Because independent claim 16 is allowable over the prior art of record, dependent claim 17 (which depends from independent claim 16) is allowable as a matter of law for at least the reason that the dependent claim 17 contains all the steps of independent claim 16. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for allowability of independent claim 16, dependent claims 17 recites further steps (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record, such as “scanning a label of said package, wherein said detecting step further includes the step of detecting said scanning step.” Thus, claim 17 is not obvious under proposed combination of *Schmier* in view of Applicant’s own disclosure and *Hitchcock*.

l. Claim 18

Applicant respectfully submits that since independent claim 16 is allowable over the prior art of record, dependent claim 18 (which depends from independent claim 18) is allowable as a matter of law for at least the reason that dependent claim 18 contains all the steps of independent claim 16. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for allowability of independent claim 16, dependent claim 18 recites further steps and/or combinations of steps (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record.

Specifically, the steps of “storing data indicating whether said package is assigned to a vehicle, analyzing said data; and performing said detecting step based on said analyzing step,” as recited in claim 18, is not disclosed or suggest by either *Schmier*, the disclosure, or *Hitchcock*.

Therefore, claim 18 is not obvious under the proposed combination of *Schmier* in view of Applicant's own disclosure and *Hitchcock*.

m. Claim 19

Applicant respectfully submits that since independent claim 16 is allowable over the prior art of record, dependent claim 19 (which depends from independent claim 16) is allowable as a matter of law for at least the reason that dependent claim 19 contains all the steps of independent claim 16. See *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

n. Claim 21

Applicant respectfully submits that since independent claim 16 is allowable over the prior art of record, dependent claim 21 (which depends from independent claim 16) is allowable as a matter of law for at least the reason that dependent claim 21 contains all the steps of independent claim 16. See *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for allowability of independent claim 16, dependent claim 21 recites further steps and/or combinations of steps (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record.

Specifically, the step of "indicating, via said notification message, a sender of said package," as recited in claim 21, is not disclosed or suggested by either *Schmier*, Applicant's disclosure, or *Hitchcock*. For example, *Schmier* seemingly suggests the broadcasting of information regarding the location and arrival of transit vehicles and does not suggest transmitting information regarding the sender of a package that is to be delivered by a delivery

vehicle. Therefore, claim 21 is not obvious under the proposed combination of *Schmier* in view of Applicant's disclosure and *Hitchcock*, and the rejection should be withdrawn.

4. Response to Rejection of Claim 8 Under 35 U.S.C. § 103(a)

Claim 8 has been rejected under 35 U.S.C. § 103(a) as being purportedly unpatentable over *Schmier* in view of Applicant's own disclosure, *Hitchcock*, and Bar Code (June 1999). It is well established at law that, for a proper rejection of a claim under 35 U.S.C. § 103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly, all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

For a proper rejection under 35 U.S.C. § 103, both the suggestion to combine the combination of references and the expectation of success of the combination must be found in the prior art, not in the Applicant's disclosure. *See In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). There is no suggestion anywhere in the prior art of record to combine the teachings of these references. Simply put, the Official Action has used Applicant's disclosure as a template or instruction manual to combine the references in order to fabricate the combination.

Further, Applicant respectfully submits that since independent claim 5 is allowable over the prior art of record, dependent claim 8 (which depends from independent claim 5) is allowable as a matter of law for at least the reason that dependent claim 8 contains all features/elements of independent claim 5. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for allowability of independent claim 5, dependent

claim 8 recites further features and/or combinations of features (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record.

Specifically, the feature wherein "said package data indicates whether said one package has been assigned to said vehicle and said system detects when said one package has been assigned to said vehicle by analyzing said package data," as recited in claim 8, is not disclosed or suggest by either *Schmier*, the disclosure, *Hitchcock*, or Bar Code. For example, the system in *Schmier* does not appear to suggest or be compatible with assigning passengers to a transit vehicle. Therefore, the *Schmier*/disclosure/*Hitchcock*/Bar Code combination simply would not result in Applicant's claimed invention. Accordingly, the rejection of claim 8 is improper and should be withdrawn.

5. Response to Rejection of Claims 11 and 20 Under 35 U.S.C. § 103(a)

Claims 11 and 20 have been rejected under 35 U.S.C. § 103(a) as being purportedly unpatentable over *Schmier* in view of Applicant's own disclosure, *Hitchcock*, and *Fruchey* (U.S. Patent No. 4,297,672). It is well established at law that, for a proper rejection of a claim under 35 U.S.C. § 103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly, all elements/features/steps of the claim at issue. See, e.g., *In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

For a proper rejection under 35 U.S.C. § 103, both the suggestion to combine the combination of references and the expectation of success of the combination must be found in the prior art, not in the applicant's disclosure. See *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). There is no suggestion anywhere in the prior art of record

to combine the teachings of these references. Simply put, the Official Action has used Applicant's disclosure as a template or instruction manual to combine the references in order to fabricate the combination.

a. Claim 11

Applicant respectfully submits that since independent claim 5 is allowable over the prior art of record, dependent claim 11 (which depends from independent claim 5) is allowable as a matter of law for at least the reason that dependent claim 11 contains all the features/elements of independent claim 5. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for allowability of independent claim 5, dependent claim 11 recites further features and/or combinations of features (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record.

Specifically, the feature wherein "said system manager is further configured to determine when said vehicle is within a predefined proximity of a premises of said one recipient based on signals transmitting from said vehicle, said system manager further configured to transmit a second notification message when said vehicle is within said predefined proximity" as recited in claim 11, is not disclosed or suggest by either *Schmier*, the disclosure, *Hitchcock*, or *Fruchey*. Particularly, a transit vehicle in the *Schmier* system seemingly does not approach the premises of package recipients. Therefore, the *Schmier*/disclosure/*Hitchcock*/*Fruchey* combination simply would not result in Applicant's claimed invention. Accordingly, the rejection of claim 11 is improper and should be withdrawn.

b. Claim 20

Applicant respectfully submits that since independent claim 16 is allowable over the prior art of record, dependent claim 20 (which depends from independent claim 16) is allowable as a matter of law for at least the reason that dependent claim 20 contains all the steps of independent claim 16. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for allowability of independent claim 16, dependent claim 20 recites further steps and/or combinations of steps (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record.

Specifically, the steps of “determining when said vehicle is within a predetermined proximity of said premises; and transmitting a second notification message in response to said determining step” as recited in claim 20, is not disclosed or suggest by either *Schmier*, the disclosure, *Hitchcock*, or *Fruchey*. For example, the system in *Schmier* does not appear to suggest a method for sending out a notification message to a recipient of a package within a predefined proximity. Therefore, the *Schmier*/disclosure/*Hitchcock*/*Fruchey* combination simply would not result in Applicant’s claimed invention. Accordingly, the rejection of claim 20 is improper and should be withdrawn.

6. Response to Rejection of Claims 22-23 Under 35 U.S.C. § 103(a)

Claims 22-23 have been rejected under 35 U.S.C. § 103(a) as being purportedly unpatentable over *Schmier* in view of Applicant’s own disclosure, *Hitchcock*, and *Nathanson* (U.S. Patent No. 5, 122, 959). It is well established at law that, for a proper rejection of a claim under 35 U.S.C. § 103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly, all

elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

For a proper rejection under 35 U.S.C. § 103, both the suggestion to combine the combination of references and the expectation of success of the combination must be found in the prior art, not in the Applicant's disclosure. *See In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). There is no suggestion anywhere in the prior art of record to combine the teachings of these references. Simply put, the Official Action has used Applicant's disclosure as a template or instruction manual to combine the references in order to fabricate the combination.

a. Claim 22

Applicant respectfully submits that since independent claim 16 is allowable over the prior art of record, dependent claim 22 (which depends from independent claim 16) is allowable as a matter of law for at least the reason that dependent claim 22 contains all the steps of independent claim 16. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for allowability of independent claim 16, dependent claim 22 recites further steps and/or combinations of steps (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record. Specifically, the step of "indicating, via said notification message, a weight of said package" as recited in claim 22, is not disclosed or suggest by either *Schmier*, the disclosure, *Hitchcock*, or *Nathanson*.

b. Claim 23

Applicant respectfully submits that since independent claim 16 is allowable over the prior art of record, dependent claim 23 (which depends from independent claim 16) is allowable as a matter of law for at least the reason that dependent claim 22 contains all the steps of independent claim 16. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for allowability of independent claim 16, dependent claim 23 recites further steps and/or combinations of steps (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record. Specifically, the steps of "maintaining a web page; receiving contact information via said web page; and utilizing said contact information to perform said transmitting step" as recited in claim 23, is not disclosed or suggest by either *Schmier*, the disclosure, *Hitchcock*, or *Nathanson*.

7. No Motivation to Combine References Under 35 U.S.C. § 103(a)

Well-established Federal Circuit case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Evidence of teaching or suggestion is "essential" to avoid hindsight. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed.Cir.1988). A description of the particular "teaching or suggestion or motivation [to combine]" is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed.Cir.1998). Indeed, in forming an obviousness type rejection, "the [Examiner] must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them." *In re Rouffet*, 149

F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed.Cir.1998). The Office Action can satisfy this burden of establishing obviousness in light of combination "only by showing some objective teaching [leading to the combination]." *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed.Cir.1992).

Applicant respectfully submits that the Office Action does not demonstrate the teaching required by the above-cited legal precedent. The Office Action merely states that "it would be obvious to one of ordinary skill in the art at the time of the invention to combine the passenger delivery system of Schmier with the package delivery system cited by the Applicant." On this basis alone, the Office Action concludes that the combination of these elements would have been "obvious," "inherent," or "naturally" self evident. *See* Office Action, pages 2-25. Applicant respectfully disagrees.

It is axiomatic in the patent laws that every patent claim is merely a novel combination of elements known in the prior art. Simply stated, the logic applied by the present Office Action could be used to reject any claim submitted for consideration. In the recently decided case of *In re Sang-Su Lee*, 277 F.3d 1338, 61 USPQ 2d 1430 (Fed Cir. 2002), the United States Court of Appeals for the Federal Circuit, reviewing an obviousness rejection by a Patent Examiner that was upheld by the Board of Patent Appeals and Interferences, stated:

The "common knowledge and common sense" on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation.

...

The patent examiner and the Board are deemed to have experience in the field of the invention; however, this experience, insofar as applied to the determination of patentability, must be applied from the viewpoint of "the person having ordinary skill in the art to which said

subject matter pertains," the words of section 103. In finding the relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint. Thus, when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

In re Sang-Su Lee, 277 F.3d 1338 at 1345.

In the same way, it takes more than the mere recognition or observation of a desire to optimize package delivery performance to lead one to the conclusion that the selective combination of elements of these various references render the presently pending claims obvious.

On this separate and independent basis, Applicant respectfully asserts that the rejection of claims 1-23 should be withdrawn.


CONCLUSION

For at least the foregoing reasons, all rejections and objections have been rendered moot, accommodated, and/or traversed, and Applicant respectfully request that all outstanding rejections be withdrawn and that all pending claims 1-23 of this application be allowed to issue. If the Examiner has any comments regarding Applicant's response or intends to dispose of this matter in a manner other than a notice of allowance, Applicant requests that the Examiner telephone Applicant's undersigned agent.

Respectfully submitted,

**THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.**

By:


Charles W. Griggers
Registration No. 47,283

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, L.L.P.
Suite 1750
100 Galleria Parkway N.W. ✓
Atlanta, Georgia 30339
(770) 933-9500

Docket No.: 50119-1060

ANNOTATED VERSION OF MODIFIED CLAIMS TO SHOW CHANGES MADE

The following is a marked up version of the amended claims, wherein brackets denote deletions and underlining denotes additions.

- 1 6. (Once Amended) The system of claim 5, further comprising a scanner configured to
- 2 scan a label of said package and to identify said one package based on said label, wherein said
- 3 system manager detects [that] that said package has been assigned to said vehicle based on whether
- 4 said scanner has identified said one package.